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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,573	11/16/2001	Ghulam Nabi Qazi	A34802 066123.0111	7857

7590 10/02/2003

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NEW YORK, NY 10112-0228

EXAMINER
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PARA, ANNETTE H

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 10/02/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/998,573

Applicant(s)

QAZI ET AL.

Examiner

Annette H. Para

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 23-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 41-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Petition Decision

Art Unit: 1661

### DETAILED ACTION

Applicant's election with traverse of Group I in paper No. 10 is acknowledged.

The claims of groups I, III, IV and V will be examined in view of applicants admission that these groups are not patentably distinct. Applicants did not traverse the restriction of group II, so the claims of group II are non-elected without traverse

Therefore, the restriction requirement between inventions I and III-V and invention II is still deemed proper and is therefore made FINAL.

Claims 1-84 are pending. Claims 1-22, and 41-84 are under examination. Claims 23-40 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 19 and 21 are objected to because of the following informalities: misspelling of the word "gibberellic". Appropriate correction is required.

Claim 41 (j, l) is objected to because of the following informalities: misspelling of the word "continuous". Appropriate correction is required.

Claim 46 is objected to because of the following informalities: inversion of the article in the recitation 'selected from a group'. Appropriate correction is required.

Claim 47 is objected to because of the following informalities: misspelling of the word "myo-inositol". Appropriate correction is required.

Claim 48 is objected to because of the following informalities: the subscript "TM" is missing after the name Tween-20. Appropriate correction is required.

Claim 59 is objected to because of the following informalities: alpha is missing in the word "alpha-naphthalene acetic acid". Appropriate correction is required.

Claim 62 is objected to because of the following informalities: the subscript "TM" is missing after the name Tween-20. Appropriate correction is required.

Claim 76 is objected to because of the following informalities: the subscript "TM" is missing after the name Tween-20. Appropriate correction is required.

Art Unit: 1661

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22, 41-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically:

Claim 14 recites the limitation "the substantial absence of light" which makes the claim vague and indefinite.

Claims 1 and 17 recite the limitation "this primary explant". There is insufficient antecedent basis for this limitation in the claim. Also note that emergence in vitro is not an "explant".

Claims 1 and 17 recite the limitation "this secondary explant". There is insufficient antecedent basis for this limitation in the claim. Also note that emergence in vitro is not an "explant".

Claims 5, 6 and 7 recite the limitation "the media". There is insufficient antecedent basis for this limitation in the claim. The claims are also confusing in the recitation "media", because "media" is plural whereas "medium" is singular.

Claim 17 recites the limitation "the seedling". There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitation "the sterilized seeds". There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitation "the parafilm-sealed". There is insufficient antecedent basis for this limitation in the claim.

Claim 41 (i) is confusing in the recitation "first culture", the word "medium" seems to be missing.

Claim 41 (j) recites the limitation "the one set". There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1661

Claim 41 (l) recites the limitation "the second set". There is insufficient antecedent basis for this limitation in the claim.

Claim 41 (f) is confusing. It appears that the medium is sterilized after the plant tissue has been placed on it, which would kill the tissue.

Claim 41 (n, o) is confusing in the recitation "third set of first medium". It is unclear if the applicants refer to the MS basal culture medium I as recited in claim 8 or to something else.

Claim 42 does not further limit claim 41. Intended use is not a limitation.

Claim 45 does not further limit claim 41. Intended use is not a limitation.

Claim 46, 60, and 74 the recitation "group comprising" is an improper Markush terminology. This would include everything, since "comprising" is open language.

Claim 49 recites the limitation "rinsed seeds". There is no rinsing step in claim 41. There is insufficient antecedent basis for this limitation in the claim.

Claims 51-56 do not further limit claim 41. Intended use is not a limitation.

Claims 50, 55 recite the limitation "the said medicinal plant". There is insufficient antecedent basis for this limitation in the claim.

Claim 57 recites the limitation "the parafilm-sealed". There is insufficient antecedent basis for this limitation in the claim.

Claim 57 recites the limitation "secondary explants". What are the primary explants? There is insufficient antecedent basis for this limitation in the claim.

Claim 57 is confusing. It appears that the medium is sterilized after the plant tissue has been placed on it, which would kill the tissue.

Claim 57 (c) recites the limitation "medium". The claim does not state the dishes contain medium. There is insufficient antecedent basis for this limitation in the claim.

Claim 58 does not further limit claim 57. Intended use is not a limitation.

Claim 62 recites the limitation "said seeds". There is insufficient antecedent basis for this limitation in the claim.

Claim 63 recites the limitation "rinsed seeds". There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1661

Claim 64 recites the limitation "the said medicinal plant". There is insufficient antecedent basis for this limitation in the claim.

Claim 64-70 do not further limit claim 57. Intended use is not a limitation.

Claim 66 recites the limitation "said plant species". There is insufficient antecedent basis for this limitation in the claim.

Claim 69 recites the limitation "the said medicinal plant". There is insufficient antecedent basis for this limitation in the claim.

Claim 69 recites the limitation "this endangered plant". There is insufficient antecedent basis for this limitation in the claim.

Claim 71 (a) recites the limitation "the fresh...medium". There is insufficient antecedent basis for this limitation in the claim.

Claim 71 it is unclear what the first and second media are.

Claim 71 it is unclear what is the primary explant. The claim only recites the fresh secondary explants.

Claim 71 (a) recites the limitation "said germinating seeds". There is insufficient antecedent basis for this limitation in the claim.

Claim 72 does not further limit claim 71. Intended use is not a limitation.

Claim 76 recites the limitation "seeds". No seeds are described in claim 71. There is insufficient antecedent basis for this limitation in the claim.

Claim 77 recites the limitation "rinsed seeds". No seeds are described in claim 71. There is insufficient antecedent basis for this limitation in the claim.

Claims 78-84 do not further limit claim 71. Intended use is not a limitation.

Claim 78 recites the limitation "the said medicinal plant". There is insufficient antecedent basis for this limitation in the claim.

Claims 1,17,18,20,22,43,57,59,71 are indefinite because they recite "MS basal culture medium", this medium could be anything as described in the specification page 7. "Variants known in the art" does not clearly set the metes and bounds of the claimed invention.

Art Unit: 1661

### **Double patenting**

Applicant is advised that should claims 41 be found allowable, claims 45, and 51-56 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claims 57 be found allowable, claims 58, and 64-70 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claims 71 be found allowable, claims 78-84 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 1-22 and 41-84 are deemed free of the prior art because the prior art fails to teach a medium comprising GA3, BAP and NAA. Although some prior art teach a mixture of growth regulator, there is no teaching or motivation to suggest the medium comprising GA3, BAP and NAA at the claimed concentration.

### **Conclusion**

Claims 1-22 and 41-84 are rejected

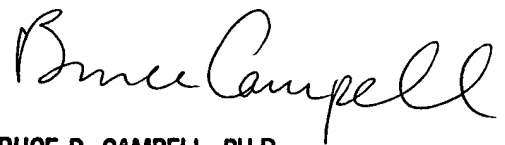
Art Unit: 1661

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax numbers for the group are Before Final (703) 872-9306 and After Final (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.



**BRUCE R. CAMPPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
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